

AFB

APRB



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0793-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
)
Sandrine DECOSTER et al.) Group Art Unit: 1617
)
Application No.: 09/692,155)
) Examiner: Gina C. YU
Filed: October 20, 2000)
)
For: COSMETIC COMPOSITIONS)
)
COMPRISING AT LEAST ONE)
)
SILICONE COPOLYMER AND AT)
)
LEAST ONE CONDITIONER, AND)
)
USES THEREOF)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated October 6, 2004. If any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. Status of Rejections

In response to the Appeal Brief filed July 14, 2004, the Examiner has maintained the following rejections:

(1) Claims 1-16, 44-47, 56, 73, 74, 81-85, 94, and 95 are rejected under 35 U.S.C. § 103(a) as unpatentable over EP 0874017 to Dalle et al. ("*Dalle*") in view of U.S. Patent No. 5,863,943 to Groh ("*Groh*");

(2) Claims 1-16, 44-71, 74, 81-84, 94, and 95 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Dalle* in view of U.S. Patent No. 5,804,207 to Dubief ("*Dubief*");

(3) Claims 1-17, 25, 27, 44-46, 56, 70, 71, 73, 74, 81-84, 94, and 95 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,183,917 to Iwao et al. ("*Iwao*") in view of *Dalle*; and

(4) Claims 18-24, 26, 28-43, 47-51, 60, and 65-69 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Iwao* in view of *Dalle* and further in view of U.S. Patent No. 6,039,936 to Restle et al. ("*Restle*").

Examiner's Answer, pages 3-7.

II. Response to Examiner's Arguments in the Answer

In the Answer, the Examiner has maintained the four § 103(a) rejections as set forth above and presented her position on each rejection in much detail. Appellants believe that the Examiner's positions have already been addressed in large part in the Appeal Brief, and thus maintain that a *prima facie* case of

obviousness has not been established for the reasons set forth in the Appeal Brief filed July 14, 2004, as well as for a few additional reasons below.

The Examiner relies heavily on the teaching in *Dalle* at page 5, line 49 - page 6, line 7 in support of the requisite evidence of a suggestion or motivation to combine and of a reasonable expectation of success to establish a *prima facie* case of obviousness. See e.g., Examiner's Answer, page 7, last paragraph - page 8, line 9; page 9, lines 5-6; page 10, lines 2-3; page 15, lines 5-7, 10-11, and 15-16. Specifically, the Examiner alleges that *Dalle* "provides ample motivation for a routin[i]er to use the Dalle silicone copolymer in formulating the disclosed cosmetic compositions." *Id.* at page 8. The Examiner admits that *Dalle* does not teach "the specific formulation of the[] cosmetics" as presently claimed. *Id.* Therefore, the Examiner relies on the other references, i.e., *Groh*, *Dubief*, and *Iwao*, respectively, for the teaching of specific formulations "for skin lotion, hair shampoo, and hair conditioner comprising the presently claimed conditioning oil component." *Id.* In other words, the Examiner alleges that because of the teaching in *Dalle* at page 5, line 49 - page 6, line 7, that its silicone copolymer can be used in personal care applications, it would have been obvious to use *Dalle*'s silicone copolymer in any cosmetic formulation, such as those disclosed in *Groh*, *Dubief*, and *Iwao* in order to achieve the present invention as presently claimed. Appellants respectfully disagree.

The teaching in *Dalle* at page 5, line 49 - page 6, line 7 heavily relied upon by the Examiner is extremely broad. Specifically, *Dalle* teaches its silicone-in-water emulsions are useful in various applicable cosmetic compositions for

beneficial properties (page 5, line 49 - page 6, line 1) and "are added to conventional ingredients for the personal care product chosen" with ingredients from a laundry list of conventional personal care ingredients (page 6, lines 2-7). However, there is no suggestion or guidance to choose one type of cosmetic composition over other types, nor any suggestion or guidance to choose one ingredient over others. Reading this broad teaching in *Dalle*, alone or in combination with *Groh*, *Dubief*, or *Iwao*, one of ordinary skill in the art would not have been motivated to use *Dalle*'s silicone copolymer with the at least one conditioning agent, such as synthetic oil, *i.e.*, the specific combination as presently claimed, because no expression of the desirability to do so exists in any of the cited references. "[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis in original and emphasis supplied).

Further, even assuming, for the sake of argument, that *Dalle*'s silicone copolymer could be used in the formulations of *Groh*, *Dubief*, or *Iwao*, there is no suggestion or guidance in any of the references to lead one of ordinary skill to form the specific combination, *i.e.*, the at least one conditioner, such as synthetic oils, and the at least one silicone copolymer, as presently claimed. The Federal Circuit has held that "[t]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by

the applicant.” *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ3d 1313, 1316 (Fed. Cir, 2000) (emphasis added).

As discussed above, *Dalle* teaches broadly that its silicone emulsions can be “added to conventional ingredients for the personal care product chosen” with ingredients from a laundry list of conventional personal care ingredients (page 6, lines 2-7). Similarly, as discussed in the Appeal Brief filed July 14, 2004, in each formulation disclosed in *Groh*, *Dubief*, or *Iwao*, there are many ingredients to choose from. Neither *Dalle* nor *Groh*, *Dubief*, or *Iwao* provides a suggestion or any guidance to pick and choose at least one conditioning agent, such as a synthetic oil, and combine it with *Dalle*’s silicone copolymer. At best, the Examiner has adopted an obvious-to-try approach.

However, in moving from the prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious *to try*. Rather, the proper test requires determining what the prior art would have led the skilled person *to do*. The Federal Circuit has given some examples of what would constitute an “obvious to try” modification based on the prior art. See *In re O’Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). For example, “what was ‘obvious to try’ was to explore . . . general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.” *Id.* 853 F.2d at 903, 7 USPQ2d at 1681 (citations omitted).

In the present case, *Dalle*, at best, provides only general guidance to use its silicone copolymer with conventional personal care ingredients. See page 6,

lines 2-7. Only in hindsight, using the present invention as a blueprint, could it have been obvious to one of ordinary skill with the cited references before him/her to make the specific combination to reach the invention as presently claimed. Yet, the use of hindsight is improper. Further, while the prior art may make it obvious for one to *try* to combine *Dalle*'s silicone copolymer with conventional personal care ingredients, with only one possible combination among many others being the subject of the present claims, "obvious to try" is not the proper standard to support a rejection under section 103 either.

Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.2d 1361, 1371, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000).

In addition, and more importantly, despite her heavy reliance on the teaching in *Dalle* at page 5, line 49 - page 6, line 1 (i.e., paragraph [0043]), the Examiner apparently neglects the fact that, at beginning of paragraph [0043], *Dalle* teaches that "[t]he emulsions of the invention [in *Dalle*] are useful in the standard applications for silicone emulsions." Page 5, line 49. Therefore, as taught by *Dalle*, it is the silicone **emulsions** of *Dalle*, instead of the silicone **copolymer** disclosed in *Dalle*, that are useful for personal care applications. The Examiner recognizes and admits that an emulsion "has a structural limitation" and "requires a dispersed phase in the continuous outer phase." Examiner's Answer, page 13, lines 4-5. Further, one of ordinary skill in the art would recognize the difficulties of forming a stable emulsion, such as a silicone-in-water emulsion, which can provide beneficial properties in personal care applications. See e.g., *Dalle*, page 2, lines 6-27. Therefore, once a silicone emulsion is

formed, it should be used where appropriate for use of a silicone emulsion, as clearly taught in *Dalle*. See *Dalle*, page 5, line 49. However, none of *Groh*, *Dubief*, and *Iwao* teach that a silicone emulsion can be used in their compositions. Accordingly, one of ordinary skill in the art would not have been motivated to combine the silicone emulsion taught in *Dalle* with the compositions disclosed in *Groh*, *Dubief*, or *Iwao*.

For at least these additional reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, this rejection should be reversed and withdrawn.

III. Conclusion

Accordingly, Appellants respectfully request that each rejection be reversed and withdrawn.

Please grant any extensions of time required to enter this brief and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, L.L.P.

Malika V. L. J., Reg No 39,064

Dated: December 6, 2004

By: *for*

Ningling Wang

Reg. No. 52,412